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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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EXAMINER	
BARQADLE, YASIN M	

ART UNIT	PAPER NUMBER
2153	

DATE MAILED: 04/05/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	09/645,645	WOODS ET AL.	
	Examiner	Art Unit	
	Yasin M Barqadle	2153	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *16 January 2004*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-23* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-23* is/are rejected.

7)☒ Claim(s) *1* is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

Response to Amendment

1. The amendment filed on January 16, 2004 has been fully considered but are moot in view of the new ground(s) of rejection.

- New claims 22-23 are added
- Claims 1-23 are presented for examination.

In response to applicant's arguments on page 11 that `` Pace cannot support the proposition that a single e-mail message produces multiple digital IDS.'' Examiner disagrees and would like to point out to the applicant col. 4, lines 6-12 where Pace shows that the digital ID generated may be one hash or multiple hashes of the data under consideration. One of such data under consideration being portions of the body of the messages. In col. 4, lines 60-64, Pace further teaches generating digital Ids from an e-mail (single email), which is received. See also Col. 5, lines 14-17 where Pace discloses that one or more digital identifiers are generated from a particular e-mail. Therefore, Pace's teachings clearly support the proposition that a single e-mail message can produce multiple digital IDs.

In response to applicant's argument that ``neither Cotton nor Pace teach or suggest a predetermined threshold.'' Examiner disagrees; Pace teaches an algorithm for determining whether a message is Spam. The algorithm can analyze messages for the frequency of particular letters or words, and/or the relationship

of the most common words to the second most common words in a particular message. Therefore, there must be a predetermined threshold in order to identify an electronic message as a Spam where analyzing and generating one or more digital identifiers is stopped (col. 6, lines 36-42).

Double Patenting

A rejection based on double patenting of the "same invention" type finds its support in the language of 35 U.S.C. 101 which states that "whoever invents or discovers any new and useful process ... may obtain a patent therefor..." (Emphasis added). Thus, the term "same invention," in this context, means an invention drawn to identical subject matter. See *Miller v. Eagle Mfg. Co.*, 151 U.S. 186 (1894); *In re Ockert*, 245 F.2d 467, 114 USPQ 330 (CCPA 1957); and *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970).

A statutory type (35 U.S.C. 101) double patenting rejection can be overcome by canceling or amending the conflicting claims so they are no longer coextensive in scope. The filing of a terminal disclaimer cannot overcome a double patenting rejection based upon 35 U.S.C. 101.

Claims 1-23 are provisionally rejected under 35 U.S.C. 101 as claiming the same invention as that of claims 1-23 of copending Application No. 09728524. This is a provisional double patenting

rejection since the conflicting claims have not in fact been patented.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

> The specification shall c onclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claim 1 is rejected under 35 U.S.C. 112, second paragraph, as being incomplete for omitting essential steps, such omission amounting to a gap between the steps. See MPEP § 2172.01. The omitted steps are: While the ``first portion'' and `` second portion'' are located as part of the method, absent a step of measuring or somehow determining the size of the first and second portions, it is unclear how the steps of ``generating a first code smaller than the first portion'' and generating a second code smaller than the second portion'' (emphasis added) can take place.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior

> art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

Claims 1-22 are rejected under 35 U.S.C. 103(a) as being unpatentable over Cotten USPN (6330590) in view of Pace et al USPN (6460050).

As per claim 1, Cotten teaches a method for automatically processing electronic mail, comprising:

loading an electronic mail message [Col. 2, lines 18-27];

removing non-textual information from the electronic mail message [note: eliminating personalization and addressing portion Col. 2, lines 18-27];

Although Cotten shows substantial features of the claimed invention, he does not explicitly show locating a first portion from the electronic mail message and generating a first code (digital id) smaller than the first portion and indicative of the first portion.

Nonetheless, this feature is well known in the art and would have been an obvious modification of the system disclosed by Cotten, as evidenced by Pace et al USPN. (6460050).

In analogous art, Pace et al disclose a system that identifies whether a piece of e-mil is Spam by generating digital Ids from portions of the body of the e-mail message. As a result the digital Ids contain a hashed data of variable length [Col. 4, lines 3-14 and 53-64].

Giving the teaching of Pace et al, a person of ordinary skill in the art would have readily recognized the desirability and the advantage of modifying Cotten by employing the system of Pace et al in order to provide a content classification system that can identify any sort of text or binary data which resides on or is transmitted through a system in a an efficient and up-to-date manner [Col. 3, lines 8-27].

Pace et al further teach locating a second portion from the electronic mail message and generating a second code smaller than the second portion and indicative of the second portion [Col. 4, lines 3-64 and col. 5, lines 14-17], [See also Cotton, Col. 3,lines 47-67 and Col. 4, lines 1-12 where the signature is coded in abbreviated format]; and

storing the first code and the second code [abstract and Col. 4, line 53 to col. 5, line 17].

As per claim 2, Pace et al teach the method for automatically processing electronic mail of claim 1, wherein the storing the first code and the second code comprises storing the first code and second code to semiconductor memory [Col. 2, lines 22-29].

As per claim 3, Pace et al teach method for automatically processing electronic mail of claim 1, wherein the locating the first portion uses a different algorithm than the locating a second portion [Col. 3, line 65 to col. 4, line 14; col. 6, lines 36-42].

As per claim 4, Pace et al teach method for automatically processing electronic mail of claim 1, further comprising:

locating a second through nth portions [digital ID generated may be multiple hashes and the hashing algorithm may performed on all or some portions of the body message [Col. 4, lines 6-14]; and

interrupting the locating the second through nth portions when a total number of portions reaches a predetermined count [messages analyzed for the frequency of particular letters or words, and/or the relationship of the most common words to the second most common words in a particular message until it is determined as a Spam Col. 6, lines 6 to col. 7. line 17].

As per claim 5, Cotten teaches method for automatically processing electronic mail of claim 1, wherein the non-textual information includes at last one of header information, a subject line, an Internet protocol (IP) address, routing information, hypertext markup language information, and an embedded applet [Col. 3, lines 47-67].

As per claim 6, Cotten teaches method for automatically processing electronic mail of claim 1, further comprising removing everything from the electronic mail message except a message body [Col. 3, lines 59-67].

As per claim 7, Pace et al teach method for automatically processing electronic mail of claim 1, further comprising arranging the first code and the second code according to numerical value [the system utilizes a hashing process to produce digital IDs Col. 2, lines 22-34].

As per claim 8 and 15, claims include similar limitations of claims 1 and 4 above. Therefore, they are rejected with the same rationale. Pace further teaches an algorithm for analyzing messages for the frequency of particular letters or words, and/or the relationship of the most common words to the second most common words in a particular message in order to identify a message as a Spam. Therefore, there must be a predetermined threshold in order to identify an electronic message as a Spam where analyzing and generating one or more digital identifiers is stopped (col. 6, lines 36-42). Pace teaches generating one or more digital ids from a particular email message (col. 5, lines 14-17 and therefore it is obvious that each digital id that is generated corresponds to a particular portion of the message (i.e., first id to a first portion and second id to a second portion etc.).

As per claims 9 and 16, Cotten teaches the method for automatically processing electronic mail further comprising removing non-textual information from the electronic mail message [Col. 3, lines 59-67].

As per claims 10 and 17, Cotten teaches the method for automatically processing electronic mail, wherein the non-textual information includes at least one of header information, a subject line, an internet protocol (IP) address, routing information, hyper-text markup language information, and all embedded applet [Col. 3, lines 47-67].

As per claims 11 and 18, Pace et al teach the method for automatically processing electronic mail further comprising interrupting the selecting the third number of portions from the electronic mail message if the third number reaches a predetermined count [Col. 6, lines 6 to col. 7. line 17].

As per claims 12 and 19, Pace et al teach the method for automatically processing electronic mail further comprising arranging the fourth number of codes according to a numerical value [the system utilizes a hashing process to produce digital IDs Col. 2, lines 22-34].

As per claims 13 and 20, Pace et al teach the method for automatically processing electronic mail wherein each code is smaller its respective portion [the system utilizes a hashing process to produce digital IDs Col. 2, lines 22-34].
As per claims 14 and 21, Cotten teaches the method for automatically processing electronic mail wherein generating the plurality of codes includes processing the plurality of portions

with an algorithm selected from the group consisting of a checksum, a cyclic redundancy check [Col. 2, lines 28-38]. As for, processing plurality of portions with a hash algorithm [see Pace et al, col. 4, line 2-14].

As per claim 22, Pace teaches the method for automatically processing electronic mail of claim 1, wherein content of the electronic mail message influences the locating steps, whereby locations for the first and second portions varies from message to message (col. 2, lines 24-56).

Claim 23 is rejected under 35 U.S.C. 103(a) as being unpatentable over Cotten USPN (6330590) in view of Pace et al USPN (6460050) and further in view of Rast US Pub (20010034769).

As per claim 23, although Cotten and Pace show substantial features of the claimed invention, they do not explicitly show a non-textual information including hypertext markup language code.

Nonetheless, this feature is well known in the art and would have been an obvious modification of the system disclosed by Cotton and Pace, as evidenced by Rast US Pub (20010034769).

In analogous art, Rast whose invention is about a system for sending temporally displaced electronic messages and the integration of additional content with the electronic messages, discloses a non-textual items such as an html code embedded with an email message [paragraphs 0006 and 0059].

Giving the teaching of Rast, a person of ordinary skill in the art would have readily recognized the desirability and the advantage of modifying Cotten and Pace by employing the system of Rast so that embedded contents such advertisement messages and multimedia contents are conveyed to email recipients.

Conclusion

The prior made of record and not relied upon is considered pertinent to applicant's disclosure.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Yasin Barqadle whose telephone number is 703-305-5971. The examiner can normally be reached on 9:00 AM to 5:30 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Glenn Burgess can be reached on 703-305-4792. The fax phone numbers for the organization where this application or proceeding is assigned are 703-872-9306 for regular communications and 703-746-7238 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-305-3900.

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